Filed on behalf of Oxbo International Corporation

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

H&S MANUFACTURING COMPANY, INC.

Petitioner,

v.

OXBO INTERNATIONAL CORPORATION

Patent Owner.

Case IPR2016-00950
Patent 8,166,739

PATENT OWNER'S SURREPLY TO PETITIONER'S REPLY

Petitioner introduced for the first time in its Reply to Patent Owner Response (Paper 28) the Operator's Manual for Petitioner's infringing Tri-Flex merger (EX1025) and purported AE50 Award Entry Information for the 2004 AE50 Award (EX1026). However, not only are EX1025-1026 not admissible for the reasons set forth in Papers 35 and 41, those Exhibits do not rebut Patent Owner's secondary considerations of nonobviousness.

I. EX1025 fails to rebut Patent Owner's secondary considerations of nonobviousness

Petitioner incorrectly argues that Dr. Chaplin conflated copying with infringement, and that EX1025 refutes the copying evidence provided. This is incorrect. As in the *Wyers* case cited by Petitioner, copying requires "evidence of efforts to replicate a specific product." *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed.Cir.2010). Patent Owner's evidence included (1) *unrebutted* testimony that Petitioner inspected Patent Owner's patented windrow merger, and (2) analysis by Dr. Chaplin that Petitioner's infringing Tri-Flex windrow merger *looked* and *operated* just like Patent Owner's, including the claimed features of the '739 patent. (EX2008, ¶¶ 83-95.)

Petitioner contends that Dr. Chaplin "ignores the claim limitation that the belt conveyors are 'operable in either direction *independently of the other belt conveyors*.'" (Paper 28, p. 17) (citing EX2008, ¶ 91.) Petitioner argues that the Tri-

Flex does not meet that claim limitation because "there is no separate button for independently controlling the direction of the middle conveyor." (Paper 28, p. 17, citing EX1025.) Petitioner's argument about the lack of a center conveyor button is misleading. The Tri-Flex center conveyor direction is controlled to operate in either direction by single tapping or double tapping either directional button. (*See* EX1025, p. 23.) To the extent that Petitioner maintains that a dedicated center button is required to satisfy this limitation, then Petitioner's prior art also lacks this limitation. Neither Declementi nor US Honey teach or suggest a center button to control the direction of a center conveyor.

Petitioner's attempt to rebut copying by establishing noninfringement is further belied by the findings of the District Court and the inspection by Dr. Chaplin. The District Court considered all the evidence, including EX1025, and found on summary judgment that the Tri-Flex met every limitation of claim 1 of the '739 patent. (EX2020 at 33-35, 38.) Addressing the limitation at issue, the District Court held that it "simply requires that each conveyor be able to operate in both directions and, if desired, in a direction different than the others." (EX2020, p. 35.) Further, Dr. Chaplin inspected the Tri-Flex multiple times and observed independent operation of the belt conveyors. Indeed, paragraph 91 of Dr. Chaplin's declaration, cited by Petitioner as purported evidence that he did not consider this limitation, expressly addresses this limitation. (Paper 28, p. 17)

(citing EX2008, ¶ 91.) Furthermore, in EX2015, Dr. Chaplin states "*I have witnessed the H&S Tri-Flex in operation*. Each of the first, second, and third belt conveyors were operable in either direction independently of the other belt conveyors. In other words, each of the belt conveyors can operate to the right or left and in a different direction than each of the other belt conveyors." (EX2015, p. 2) (emphasis added.)

Accordingly, even considering EX1025, the Tri-Flex was designed after review of the patented Oxbo merger, and includes the limitation that Petitioner alleges is missing. Petitioner's copying rebuttal therefore fails.

II. EX1026 fails to rebut Patent Owner's secondary considerations of nonobviousness

Petitioner attempts to rebut evidence of industry praise by speculating that the "AE50 award is not an objective award" and cites to EX1026 in support. (*Id*., p. 19.) Contrary to Petitioner's argument, EX1026 shows that the award winners are selected by a "panel of experts in these fields." (EX1025.) Furthermore, Dr. Chaplin testified that his opinion of the significant industry praise bestowed by AE50 award would not change even if the submissions were self-nominated, or if the descriptions of the awarded products were submitted by the winner. (EX1024, p. 166:10-25; p.168:22-169:7.) As such, both Dr. Chaplin's testimony and EX1026 undercut Petitioner's argument.

Respectfully submitted,

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